

REMARKS

The Specification has been amended to include the relevant SEQ ID NOs. Applicant directs entry into the Specification a Substitute Sequence Listing submitted herewith. The Substitute sequence listing incorporated the sequences appearing in Figure 2. Claim 16 has been amended. Support for the amendments can be found in the original claims 1-15. New Claims 22-25 have been introduced. Support for the new claims can be found in original Claims 3, 6, 12 and 14. No new matter has been introduced by these amendments. The following addresses the substance of the Office Action.

Specification

The Examiner has objected to the Specification for lacking sequence identifiers on pages 4, 8 and in the Brief Description of Figures 1 and 2. Applicant has amended the Specification accordingly and also has submitted the Substitute Sequence Listing which now includes the sequences from Figure 2. The Examiner noted that it was unclear if "EYFP" on page 7, line 6 meant the sequence of four amino acids. "EYFP" is not meant to represent any amino acids, as it stands for "enhanced yellow fluorescent protein". Therefore, the Specification is now in compliance with the Sequence Rules.

Claim Objections

The Examiner has objected to Claim 16 and 17 for being dependent on non-elected and withdrawn claims. Claim 16 has been amended to be an independent claim. Therefore, this objection is now moot.

Written description

The Examiner has rejected Claims 16 and 17 under 35 USC §112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Examiner pointed out that the claims 16 and 17 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art at the time the application was filed.

Claim 16 has been amended to restrict the monitor protein by incorporating the following limitations:

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|----------------------------------|--|
| "processing cleavage region" to: | "a processing cleavage region composed of a sequence of 10 to 40 amino acids including a cleavage point (Lys-Arg) cleaved by the processing enzyme PC1 or PC2" |
| "luminescent protein" to: | "secretory <i>Cypridina noctiluca</i> luciferase" |

"fluorescent protein" to: "yellow fluorescent protein (YFP)."

These amendments are fully supported by the Specification as filed, for example, in Table 1 (page 9) and Table 2 (page 11). Therefore, the specification as filed clearly evidences that Applicants were in possession of the complete scope of currently amended claims 16 and 17, as well as new Claims 22-26, at the time the specification was filed. Accordingly, withdrawal of the written description rejection is respectfully requested.

Enablement

The Examiner has rejected Claims 16 and 17 under 35 USC §112, first paragraph, as allegedly failing to comply with the enablement requirement. Specifically, the Examiner stated that there is no description in the Specification of how one skilled in the art would introduce monitor proteins back into a cell. Claim 16 has been amended to limit the subject matter such that the monitor proteins are introduced into the cell by introducing the DNA encoding the monitor protein. This amendment is fully enabled in the Specification (see, Examples 1-4).

The monitor protein can be expressed from the DNA via an expression vector, as set forth in Claim 26. The monitor protein can also be expressed from the DNA via any of a number of other methods well-known to those having ordinary skill in the art, such as through electroporation. Therefore, Claims 16 and 17, as well as the new Claims 22-25 are fully enabled.

CONCLUSION

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicants reserve the right to pursue at a later date any previously pending or


other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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